REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated April 3, 2008.

Claim Rejections – 35 USC 103

The Applicant maintains that the subject-matter of the present claims is not obvious in view of the combined teachings of Perazza, Sekendur and the newly cited O'Donnell.

The Examiner has apparently cited O'Donnell, because O'Donnell is alleged to teach the claim feature of:

"computing a position of the nib from an observed perspective distortion on the imaged tag and a known geometry of pen optics"

The Applicant contests the relevance of O'Donnell for at least the following reasons:

O'Donnell Does Not Qualify as Prior Art Against the Present Application

In the first place, the Applicant submits that O'Donnell does not qualify as prior art against the present application under 35 USC 102 and cannot, therefore, be used in support of an obviousness rejection under 35 USC 103.

O'Donnell has a US filing date of September 5, 2000. Since O'Donnell is a Continuation-in-Part application and the relevant subject-matter was not disclosed in any earlier applications in the continuation chain, then O'Donnell is not entitled to the benefit of priority for any preceding parent applications. Thus, O'Donnell has an effective US filing date of September 5, 2000 for the purposes of 35 USC 102(e).

However, the present application has an effective date of May 25, 1999 by virtue of its claim to earlier foreign priority (Australian Provisional Application PQ0559). Hence, the effective date of the present application *precedes* the US filing date of O'Donnell.

Under such circumstances, O'Donnell cannot be cited as prior art against the present application under 35 USC 102, nor can O'Donnell be used to allege obviousness under 35 USC 103.

Since O'Donnell does not qualify as prior art against the present application, it is submitted that any rejection made in view of O'Donnell is improper and should be withdrawn.

O'Donnell Fails to Teach the Relevant Claim Feature

The Examiner has cited some lengthy passages of O'Donnell [column 4, lines 1-67; column 5, lines 1-35; and column 2, lines 1-67). The Examiner has quoted from and appears to focus on the passage at column 4, line 47 *et seq*, which discusses various means by which the commencement of a writing stroke may be detected in O'Donnell's pen. For example, a button, a microaccelerometer or a strain gauge may be used.

Claim 1 requires computation of the position of the nib using "an observed perspective distortion on the imaged tag and a known geometry of pen optics". There is nothing whatsoever in O'Donnell teaching the skilled person to use "an observed perspective distortion on the imaged tag and a known geometry of pen optics" to calculate the nib

position. O'Donnell's discussion of buttons, microaccelerometers and strain gauges does not suggest to the skilled person in any way to use, *inter alia*, an observed perspective distortion on an imaged tag to calculate nib position.

Whilst O'Donnell may appreciate the problem of knowing the nib position in an optical writing instrument, O'Donnell never suggests the presently claimed solution to this problem. Indeed, it would have been impossible to derive the present invention from O'Donnell, because O'Donnell specifically demands that the writing surface does not contain any special position-coding pattern (see claim 1 of O'Donnell). The skilled person understands that O'Donnell's pen is merely functioning as a traditional optical mouse, which is incapable of using perspective distortion in the manner of the present invention, because there are no 'tags' on O'Donnell's writing surface.

Since there is nothing in O'Donnell teaching the claim feature of "computing a position of the nib from an observed perspective distortion on the imaged tag and a known geometry of pen optics", it is submitted that the present invention is not obvious in view of O'Donnell when combined with Perazza and Sekendur.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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